

REMARKS

In the parent application Ser. No. 09/675,259 filed September 28, 2000, a Final Office Action dated July 16, 2003, rejected claims 1-10 for being unpatentable over Avery in view of Davidson. The present continuation application has been filed to further prosecute claims 1-10. Thus, the instant Preliminary Amendment will address the rejections from the parent application's Final Office Action.

A. 35 U.S.C. § 103(a)

Avery - Claim 1-10

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the U.S. Patent No. 6,181,008 issued January 30, 2001 to Leslie Avery, et al. (hereinafter "the Avery patent") in view of the EP patent application No. 0 622 847 A2 published February 11, 1994 to Evan Davidson et al. (hereinafter "the Davidson reference") (Final Office Action, page 2). For at least the reasons set forth below, Applicant submits that the claims 1-10 are not rendered obvious by the Avery patent in view of the Davidson reference.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to claims 1-10, the Office relies on the Avery patent for a teaching of a “power converter adapted to convert the voltage corresponding to an array of contacts on the land grid array socket.” (Final Office Action, page 2). The Office admits the Avery patent does not disclose contacts placed on the surface of a power converter, as in independent claims 1 and 6 of the present invention. The Office relies on the Davidson reference for disclosing contacts placed on the surface of chips, and contends that “it would have been obvious to place the grid array socket on an array of contacts mounted on the surface of the power converter, since the rearranging of parts of an invention involves only routine skill in the art” under *In re Japikse* (Final Office Action, page 3).

As previously stated by the applicant, the Avery patent teaches a power supply circuit chip (DC-DC converter, col. 3, line 38) 34 which is mounted in each of the recesses 24 in the body 14 of the substrate (LGA socket) 12 (col. 3, lines 31-32). The array of contacts associated with the socket at 18 or 20 are located on the substrate, as shown in FIG.1, but the Avery patent does not teach an array of contacts on a surface of the power converter chip 34, as required by independent claims 1 and 6 of the present invention. Thus the Avery patent does not teach or suggest all of the limitations of independent claims 1 and 6 of the present invention.

Independent claims 1 and 6 of the present invention teach an array of contacts on a surface of a power converter (i.e. a DC-DC voltage regulator) that converts higher voltage supplied from a power supply to a lower voltage which is typically utilized by an integrated circuit device, as is well known in the art (Detailed Description of the invention, page 7, lines 18-22).

The Office contends that the Davidson reference teaches contacts placed on the surface of chips (see Final Office action, page 2). However, these chips are not power converters, i.e. they are not DC-DC voltage regulators, as required in independent claims 1 and 6 of the present invention. In fact, the Davidson reference teaches away from the use of a power converter, since the electronic devices (chips) of the Davidson reference are preferably logic or memory devices (col. 5, lines 30-34) (which do not convert a high voltage from a power supply to a lower voltage for use by an integrated circuit). “It is improper to combine references where the references teach away from their combination.” *In re Graselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Thus, since the Davidson reference teaches away from the use of contacts on a surface of a power converter, it is improper to combine the Avery patent with the Davidson reference.

Therefore, since there is no suggestion or motivation to modify or combine the Avery patent and the Davidson reference, the examiner has failed to establish a prima fascia case of obviousness. In addition, the Applicants respectfully point out that the Davidson reference does not include the limitation of a power converter that comprises an array of contacts on its surface. Neither the Avery patent nor the Davidson reference, either alone or in combination with each other, teach or suggest all of the limitations of the present invention. It would not have been obvious to rearrange parts, or limitations, such as an array of contacts on the surface of a power converter, that do not exist in the references cited by the Office. Thus, claims 1 and 6 are not rendered obvious by the Avery patent in view of Davidson reference.

If an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1998). Because dependent

claims 2-5 and 7-10 depend from claim 1 and 6 respectively, Applicant submits that claims 2-5 and 7-10 are not rendered obvious by the Avery patent in view of the Davidson reference.

Therefore, reconsideration and withdrawal of the Section 103(a) rejection of claims 1-10 are respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed agent to further the prosecution of the application, the contact number is (503) 264-0944.

Respectfully submitted,



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